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APPLICATION NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NUMBER	CONFIRMATION NO.
09/582,554	06/28/2000	YOKO TATSUMI	4629.006	8304

7590 10/28/2002

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EXAMINER

PESELEV, ELLI

ART UNIT	PAPER NUMBER
1623	9

DATE MAILED: 10/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/582,554	TATSUMI ET AL.
	Examiner	Art Unit
	Elli Peselev	1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-25 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

[illegible]

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other

Claim 12 is are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds having an apoptosis-inducing ability, does not reasonably provide enablement for "therapy or prevention of a disease having a sensitivity to a compound" (claim 12). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. It would take an undue amount of experimentation to determine for the treatment of which specific diseases the claimed agents are useful. Further, there is of evidence of record showing that the clamed compounds useful in the prevention of any disease. Since it is not known in the art that similar compounds have preventive properties, there is a good reason to doubt that the claimed compounds are useful in prevention of a disease.

Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The method claims 1-9 and 25 are indefinite in that the structure of the final product is not clear. The term "heating" (claim 1) renders the method claims 1-10 and 16-25 indefinite in that the temperature of the heating nor the time period of the heating process have been set forth. The method claims 1-10 and 14-24 are also indefinite in that it is not clear what specific compound was heated in order to produce what specific final product.

Claims 12 and 13 are substantial duplicates.

Claims 14 and 15 are substantial duplicates.

The terminology "agent are" (claim 13) is an improper domestic terminology.

It is not clear what compounds are encompassed by the food or beverage claims 14-15.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

and invention dates of each claim that was not commonly owned at the time a

later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10 and 16-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dobler et al (U.S. Patent No. 5,015,296) or Izawa et al (U.S. Patent No. 5,792,868).

Dobler et al disclose the claimed process of heating pentose (column 3, lined 5-7.

Izawa et al disclose the claimed process of heating a ribonucleoside (column 3, lines 35-40).

The claimed process is anticipated by Dobler et al or Izawa et al.

In addition, if there are any differences between the claimed process and the prior art process, the differences would appear to be minor in nature and the claimed process, which falls within the scope of the prior art process, would have been prima facie obvious from the said prior art disclosure to a person having ordinary skill in the art at the time the instant invention was made.

Claims 11-15 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ikariya et al (U.S. Patent No. 6,184,381 B1) or Rosenschein et al (U.S. Patent No. 5,984,882).

Ikariya et al disclose 4-hydroxy-2-cyclopenten-1-one (column 27, line 1).

Rosenschein et al disclose N-acetylcysteine and glutathione useful for

The claimed compounds and compositions are anticipated by Ikariya et al or Rosenschein et al.

In addition, when the instant claims read on compositions, the same encompass nothing more than an old compound in water and would have been prima facie obvious to a person having ordinary skill in the art at the time the instant invention was made over Ikariya et al or Rosenschein et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is 703-308-4616. The examiner can normally be reached on weekdays 8.30 a.m. - 5.00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Elli Peselev
October 25, 2002

ELLI PESELEV
PRIMARY EXAMINER
GROUP 1800